BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

Opinions of the Courts Below.

The opinion of the District Court for the Southern District of New York herein is reported in 58 F. Supp. 378 (R. 136) and the opinion of the Circuit Court of Appeals for the Second Circuit in 148 F. (2) 644 (R. 163). The earlier opinion of the Circuit Court of Appeals herein is reported in 138 F. (2) 828 (Appendix, p. 33) while the opinion of the Circuit Court of Appeals for the Eighth Circuit is reported in 123 F (2) 878.

Jurisdiction.

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925, c. 228 (28 U. S. Code, Sec. 347).

Petition for rehearing was denied on April 25, 1945 (R. 184).

The order for mandate was entered June 18, 1945 (R. 190).

Statement of the Case.

The essential facts of the case are stated in the accompanying petition for a writ of certiorari.

Specification of Errors.

The errors which petitioner will urge if the writ of certiorari is issued are that the Circuit Court of Appeals for the Second Circuit erred:

1. In holding that respondents' failure to disclaim previously invalidated claims when suit was brought more

than eleven months after the decision of the Circuit Court of Appeals for the Eighth Circuit holding only claim 2 valid, while claims 1 and 3 remained invalid and void by reason of an earlier decision, which failure to disclaim continued to the date of expiration of the patent (March 23, 1943), was excused by the fact that, according to the opinion of the court below, the invalidated claims were not infringed by petitioner's structures.

2. In holding that respondents were not required to try claims 1 and 3 despite the fact that the opinion of the District Judge herein holding such claims to be infringed by the same devices as were accused in the action before Judge Otis, showed that respondents could have had an adjudication on validity.

3. In construing claim 2 differently from the Circuit Court of Appeals for the Eighth Circuit and regarding as immaterial a limitation which the latter Court construed to be the only patentable difference over the prior art, and nevertheless holding petitioner-manufacturer bound by the decision in the Eighth Circuit and refusing petitioner a trial *de novo*.

4. In not holding the Campbell Patent No. 1,577,821 void when the present suit was brought for failure promptly to disclaim claims 1 and 3, or that it became void *ab initio* when respondents abandoned claims 1 and 3 and moved for summary judgment only on claim 2.

Argument.

Respondents can justify their failure to disclaim only by having the claims previously declared invalid later validated by a court of competent jurisdiction. They were under compulsion to put all of the invalidated claims in issue in the first suit after the status of the patent was by

judicial determination that of containing both valid and invalid claims. Failure to do that rendered their patent void.

When all the claims of the Campbell patent had been held invalid in the first suit, (against a different defendant), respondents were under no duty to disclaim. In their suit against petitioner's customers, respondents put only claim 2 in issue. Had this claim been declared invalid by the Court of Appeals for the Eighth Circuit, respondents again would have been under no burden to disclaim, and the Court of Appeals herein appreciated this fact in its first opinion (Appendix, p. 36). However, when the Court of Appeals for the Eighth Circuit finally declared claim 2 valid on December 1, 1941, that finally fixed the patent as containing one claim judicially declared valid and two claims judicially declared invalid. From that moment on, the time for disclaiming began to run against respondents.

However, respondents allowed more than eleven months to elapse before they brought the present suit and in that period, and subsequently, failed to avail themselves of the privilege allowed by the disclaimer statutes. The only thing that could then save their patent was to obtain a validation of claims 1 and 3 to justify their failure to disclaim. This they failed to do. Yet the decision below excuses such failure to act on the ground that although there was infringement of claim 2 in the present suit, there was no infringement of the previously invalidated claims.

We respectfully submit that the decision of the Court of Appeals is contrary to the principles and rules established by this Court in its most recent adjudications.

The Decision of the Court Below Excusing Failure Promptly to Disclaim or to Re-Litigate on the Ground that the Invalid Claims Were Not Infringed Is in Direct Conflict With Ensten v. Simon, Ascher & Co.

The Court of Appeals below sanctioned the refusal of respondents to re-litigate invalid claims 1 and 3 on the ground that, in its opinion, contradicting the decision of the District Court, such claims were not infringed by the accused devices, and hence respondents were under no duty to re-try their validity before Judge Otis.

(In view of the recognition by the Court below, in its first opinion in this case [Appendix, p. 35] of the rule that when all claims have been held invalid, there is nothing to disclaim, it would appear that the Court should have referred not to the *Otis* actions, but to the present action, which is the first in which the patent was sued on with valid and invalid claims.)

This exoneration of the patent owners who had continued to hold out the invalidated claims as valid up to the expiration of the patent is in direct conflict with the principles enunciated by this Court in *Ensten* v. *Simon, Ascher & Co.*, 282 U. S. 445.

In the cited case, an Ohio district court had held claim 2 of Ensten's patent invalid but other claims valid. The defendant appealed, but Ensten did not. After affirmance, and about two years after the district court's decree, Ensten disclaimed claim 2. Ensten sued again in the Ohio court, and the district judge dismissed the complaint because of unreasonable neglect and delay in disclaiming. The Court of Appeals reversed, holding the question of prompt disclaimer moot. Ensten then sued Simon, Ascher & Co. in New York. The District Court dismissed the action for failure promptly to disclaim, and the Court of Appeals for the Second Circuit affirmed.

This Court affirmed the invalidity of the patent and said (pp. 452, 453):

> "Construed together they [the disclaimer statutes] 'enact that where a patentee claims materially more than that which he was the first to invent, his patent is void, unless he has preserved the right to disclaim the surplus; and that he may fail to preserve that right, by unreasonable neglect or delay to enter a disclaimer in the Patent Office'.
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> "Unreasonable delay in disclaiming is thus tantamount to an original fraudulent claim, and through it the patentee loses the privilege of making the amendment by which alone his patent could be saved. The question of unreasonable delay is a question for the court, upon the facts as found either by its own investigation or the verdict of a jury.
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> "Under this view [of petitioners] a patentee having procured allowance of an invalid claim may hold it in the face of the public for years (here nearly two years) with large possible advantage to himself and much injury to others. By the assertion of his apparent monopoly he may deter others from legitimate action and seriously prejudice the public (see *Miller* v. *Brass Co.*, 104 U. S. 350, 355)."

That the patent owner is under a duty promptly either "to vindicate his position" or "to relieve the public from further evil effects of his false assertion" is emphasized in the following:

> "When a competent Court has declared his pretentions without sufficient foundation, we think good

> faith and the spirit of the enactment demand that he act with *such promptness* as the circumstances permit *either* to vindicate his position *or* to relieve the public from further evil effects of his false assertion. But for the benign provisions of the statute, such an assertion would invalidate the whole patent; and these provisions were intended to protect only those who by *prompt* action *either* seek to overturn an adverse ruling *or* retreat from a false position." (Emphasis added.)

In the cited case the plaintiff's failure to seek a review of invalid claims in issue was held to be fatal to the patent. If the same penalty does not follow here, confusion will result as to the force and effect of the *Ensten* case.

Contrary to the ruling of the court below herein, the decision in Ensten did not depend upon the question whether the invalidated claims actually were infringed. It was validity that had to be reviewed, and infringement was immaterial.

Quoting again from *Ensten* (p. 455):

> "He made no effort promptly to vindicate what he had asserted nor did he surrender it. Thus he failed to earn the offered exemption and now he may not complain."

The *Ensten* case was followed by this Court in *Altoona Public Theatres, Inc.* v. *American Tri-Ergon Corporation,* 294 U. S. 477, in which Mr. Justice Stone pointed out that

> "The settled rule that unreasonable delay in making a disclaimer invalidates the whole patent, *Ensten* v. *Simon Ascher & Co.,* 282 U. S. 445,

> 452-458; * * * rests upon the similar principle that misuse of the patent, or a part of it, by the patentee in such a manner as to mislead the public or operate to its detriment, deprives the claim of the benefit of the patent laws."

In *Radio Condenser Co.* v. *General Instrument Corp.* (C. C. A. 2) 65 F. (2) 458, the Court below, affirming the dismissal of a counterclaim for patent infringement for failure to file a prompt disclaimer, said:

> "The principle which the *Ensten* case applies is that a patentee who discovers that he has included in his claims something of which he was not the first inventor must either promptly pursue available remedies to vindicate his claimed monopoly or else surrender his pretensions. To do neither, to continue to hold his doubtful claim *in terrorem* over others, is an imposition upon the public and not permitted by the statute. When the patentee receives his warning from a competent official, whether it be by decision of a District Judge or of a Patent Office Examiner, he should be compelled to make good his claim or to renounce it."

This language is surprising because of its contrast to the position taken by the same court in the present case in which respondents were not required "either promptly [to] pursue available remedies to vindicate [their] claimed monopoly or else surrender [their] pretensions". Without a doubt respondents could have re-litigated the validity of claims 1 and 3 in the present action, especially as the district judge found infringement. The lower court's decision in the present case appears to be in conflict with its own position in the *Radio Condenser* case, and this further points up the confusion in this branch of

patent law which will result if the decision below is allowed to stand.

The decision of the Court of Appeals herein attaches to the phrase "promptly to vindicate" the qualification that, if in the later action the accused devices do not infringe the invalidated claims, the patentee need neither seek vindication nor be prompt about it. There is no justification for such qualification, and it contradicts the express meaning and effect of this Court's decisions.

The Present Case Falls Within the Situation Set Out in Footnote 3 to the Triplett v. Lowell Opinion on Which This Court Has Not Yet Ruled But Which This Court Should Settle.

In *Triplett* v. *Lowell,* 297 U. S. 638, this Court settled certain questions involving the scope and construction of the Disclaimer Statutes R. S. 4917 and 4922 (Appendix, p. 31), and held that R. S. 4922 did not bar a second suit on the invalidated claims of a patent containing also validated claims, but that if such invalidated claims on re-litigation were a second time adjudicated to be invalid, the patentee risked losing the good claims with the bad for failure promptly to disclaim. While this decision relaxed somewhat the rule established in the several Circuit Courts of Appeals requiring disclaimer within 30 or 60 days after invalidation of claims of a patent containing also valid claims, or after termination of the period for appeal, it admittedly did not rule on all aspects of the re-litigation question, but reserved an important and closely related question for the future.

This question is raised by Mr. Justice Stone in footnote 3 to *Triplett* in the following language:

> "3. We do not now determine the effect of the disclaimer statute when the second suit, either from choice or necessity, is confined to claims held valid

> or not adjudicated in the earlier action. Whether the claims previously held invalid should be deemed abandoned and properly subject to disclaimer would depend upon special circumstances and involve questions not presented in the present suit."

The situation presented by the present case is embraced by the footnote, with the damaging difference, however, that after declaring on the invalidated claims, and charging infringement and asserting validity, respondents subsequently refused to re-litigate them.

The present action being the first one in which the Campbell patent as declared on contained both validated and invalidated claims, respondents were bound according to *Triplett*, to re-litigate the invalid claims in the present action and their deliberate refusal to do so renders their patent void *ab initio*.

The holding of the court below that respondents were not required to re-litigate the invalid claims is directly opposed to the adjudication in *Triplett*.

That the views of this Court on the situation presented in footnote 3 are necessary to clarify *Triplett* and the disclaimer law generally, will be evident from *Messler* v. *United States Rubber Co.*, 53 F. Supp. 76 (D. C., D. Conn.) wherein the Court said:

> "*Triplett* v. *Lowell* leaves open the question of the effect of the disclaimer statute when the second suit is confined to claims held valid or not adjudicated in the earlier action."

It is significant that in the cited case the court permitted the plaintiff to amend his complaint and bill of particulars to put claim 2, previously held invalid and not put in issue in the pending action, in issue, to re-litigate its validity after the plaintiff had omitted it as one of the

claims in suit in his bill of particulars. Evidently, validity was to be tested even though there was no infringement. The Court of Appeals for the Second Circuit apparently evaded the question of disclaimer on the appeal in that case, for it affirmed the district court's holding of invalidity and non-infringement of the claims, but added (148 F. [2] 734, 737):

> "Inasmuch as what we have said must be determinative of the case at bar, we find it unnecessary to discuss the other questions argued on this appeal."

Throughout the *Triplett* opinion this Court emphasized that it is the validity of the previously invalidated claims which must be determined on the subsequent action before it can be ascertained whether the patent owner was justified in not disclaiming. There is not the slightest suggestion that the crucial question is infringement of such claims. The opinion states:

> "We conclude that neither the rules of the common law applicable to successive litigations concerning the same subject matter, nor the disclaimer statute, precludes re-litigation of the *validity* of a patent claim previously held invalid in a suit against a different defendant.
>
> "It follows that want of disclaimer of claims previously held invalid can never be set up as a bar *in limine* * * * since the patentee is entitled to invoke in that suit the independent judgment of the court upon the *validity* of the claims which have been held invalid. In advance of this decision as to *validity*, that court cannot consistently hold that there is necessity for disclaiming claims which, although previously adjudged invalid it may hold to be *valid* * * *.

> "The court whose jurisdiction is invoked by such a suit must determine for itself *validity* * * * If it determines that the claims previously adjudicated are *valid*, there is no occasion for disclaimer" (emphasis added).

Having declared, in their complaint, on claims 1 and 3, along with claim 2 (*i. e.* on the whole patent), respondents were duty bound to "proceed to re-litigate" such claims to establish their validity and thereby excuse their failure to disclaim. They could abandon claims 1 and 3 only at their peril. Yet this is exactly what they did when they moved for summary judgment on the pleadings, in support of which they relied on the previous adjudication of validity of claim 2.

The *Triplett* opinion clearly differentiates a situation wherein the patent owner proceeds to re-litigate invalidated claims from one in which he abandons the invalidated claims. The opinion says (297 U. S. on p. 646):

> "A different question is presented where the claims adjudged invalid are abandoned, whether by a tardy disclaimer or otherwise, and a second suit is brought to restrain infringement of other claims, see *Ensten* v. *Simon Ascher & Co.*, * * *."

We believe that the above quotation gives a clue to the answer to footnote 3. Respondents abandoned claims 1 and 3, not by disclaimer, but "otherwise", and the lower court, pursuant to the above intimation, should have declared the patent void.

Respondents had their second chance to re-litigate claims 1 and 3 in the present case, and abandoned it. *Triplett* does not give a patentee the right to evade re-litigation, nor does it give him an indefinite period of grace until he finds an infringer who will be held to be an infringer by a Circuit Court of Appeals, and not merely

by a district court. If he has an opportunity to re-litigate the valid claims, he must re-litigate also the invalid ones to justify holding them out to the public as valid and establish that this was not a fraud and a deceit on the public.

There is no authority or precedent for the lower court's imposing the condition that, once a patent contains both validated and invalidated claims, the latter claims must be infringed before they can be required to be re-litigated. No authority was cited by the court below.

We accordingly submit that the only interpretation that can be given the *Triplett* case and the only answer which can be given to footnote 3 which are consistent with the disclaimer statute, with the *Ensten* case and with other cases decided by this Court prescribing prompt disclaimer to save a patent claiming more than that of which the patentee was the first inventor, are that the patentee has the choice either of disclaiming promptly or of re-litigating at the first opportunity. If he does not find an infringer of his invalidated claims, in many instances because competitors are frightened away by such claims, but only of the validated claims, he is certainly not to be rewarded by having the operation of the common law rule that his patent is void, suspended indefinitely. To permit the view of the lower court to stand will reward those who flout the statute and introduce uncertainty as to its meaning and scope.

The Decision of the Court Below Cannot Be Reconciled With the Maytag Case.

Maytag Company v. *Hurley Machine Co.*, 307 U. S. 243, goes even further than the *Triplett* case. In *Maytag* this Court even placed upon the patent owner the burden of disclaiming or re-litigating not only claims which previously had been held invalid, but also a claim which had

not been held invalid and was not even in suit, but which was not "defintely distinguishable from the parts claimed without right". At page 246 the opinion says:

> "If claim 39 [not in suit and never held invalid] describes the same method as claim 38 [previously held invalid] it follows that failure either to sue on 39 or to disclaim it along with 38 invalidates the patent."

Contrary to the position taken by the Court of Appeals herein, *Maytag* does not inquire into the question whether claim 39 was infringed or whether the plaintiff was justified in not suing on it. The opinion states unequivocally that the patent owner must either disclaim or re-litigate, and failure to do either is fatal.

At least to some extent the *Maytag* case may be said to answer footnote 3 to the *Triplett* opinion, and this answer is that the patent owner is not free to pick his time when to re-litigate. If he has not disclaimed promptly, he must on the next suit put the validity of the condemned claims in issue to vindicate his failure to disclaim. The insistence of the court below that infringement must first appear, and not merely to a district judge but to the Court of Appeals, not only finds no support in *Maytag* but directly contradicts such case.

Claims 1 and 3 of the present case are in an even worse position than claim 39 in *Maytag*. As to whether such claim 39 was or was not "definitely distinguishable" from a previously invalidated claim was a debatable point; but claims 1 and 3 in the present case had actually been judicially declared invalid. If claim 39 of *Maytag* fell within the *Triplett* rule requiring disclaimer or re-litigation, then certainly claims 1 and 3 herein fall within such rule.

The Decision of the Court of Appeals in This Case to the Effect That the Present Action Was Properly Brought and Can Be Maintained Despite the Prior Adjudication of Invalidity of Some of the Claims of the Patent and Failure to File Prompt Disclaimer Is Directly Opposed to the Express Provisions of R. S. Sec. 4922.

R. S. Sec. 4922 states unequivocally that no patentee shall be entitled to the benefits of the remedial provisions of Secs. 4917 and 4922 nor be permitted to

> "maintain a suit at law or in equity, for the infringement of any part thereof, which was *bona fide his* own * * * if he has unreasonably neglected or delayed to enter a disclaimer."

The present action was begun long after the time for prompt disclaimer had passed, following the decree of the Circuit Court of Appeals for the Eighth Circuit. The decision of the lower court herein is directly contrary to the statute and establishes a rule in the Second Circuit, and a precedent in patent cases, in such direct conflict with the statute as to require review of the present case by this Court and the reversal thereof.

The Consequences of the Decision of the Court of Appeals Below Are Inequitable and Intolerable.

If the holding of the lower court that the owner of a patent containing both validated and invalidated claims need not re-litigate until he has found an infringer, is not reversed, it will produce consequences as inevitable as they are intolerable. Thus the decision below relieves a patentee who knows that the invalidated claims are actually invalid, of the necessity for bringing suit at any time against a competitor who infringes such claims, and the patentee thereby escapes a second holding of invalid-

ity which, according to the *Triplett* case, would cause him to lose the good claims along with the bad. If the patentee confines himself to suing competitors who infringe only his valid claims, he can, until the end of the patent term, continue holding out the invalid claims as valid and yet not be subject to attack by a defendant who infringes only the valid claims.

Still another consequence of the decision below is that of placing upon a defendant who infringes only the valid claims, the burden of showing that competing devices of third parties are actually on the market which infringe the invalid claims and that the patentee has failed to re-litigate. This would be an unfair burden on the defendant and also on the courts because, on the one hand, the defendant would have to assume the role of the patent owner and look about for infringements of the invalid claims to establish failure to seize promptly an opportunity to re-litigate; and on the other hand, it is easily conceivable that a defendant will bring into court such third party infringements of the invalid claims and also devices of third parties whose infringement could not be determined except on a trial with testimony of experts. The courts would therefore be compelled to try devices on which the patentee had not sued, to determine whether he had taken the first opportunity to re-litigate.

A further consequence is the one which already has occurred in the present suit, involving the unnatural situation before the district judge in which plaintiffs sought to prove non-infringement and the defendant to prove infringement of claims 1 and 3.

It was not the intent of the disclaimer statutes to permit a patentee, whose patent has been judicially declared to contain both valid and invalid claims, to hold out the invalid claims to the public as valid *indefinitely*. To interpret the statutes otherwise would enable the patentee to frighten competitors out of the field with invalid claims

by threat of suit, and at the same time permit him to complain that he could not obtain a judicial re-determination because there were no infringers. The patentee would, therefore, be profiting by his own wrong.

According to the decision sought to be reviewed, the more effectively the patentee keeps from the public that to which they are entitled, the less liable is he to suffer the penalty for failure to disclaim invalid claims.

The Different Constructions Given to Claim 2 by the Circuit Courts of Appeals for the Eighth and Second Circuits Necessitate Review by This Court, as Does the Fact That the Court Below Went Outside Its Province in Modifying Claim 2 in the Absence of Trial of Such Claim.

In reversing the district judge's holding that claims 1 and 3 were infringed by the accused devices, the court below found it necessary to re-interpret the claims, particularly claim 2, and treat the matter as if there had occurred that trial on the merits which the court had previously refused to grant on the ground of *res judicata*. This placed petitioner at a decided disadvantage, because it had no opportunity to present the prior art and show how the claims must be construed in the light of such art.

Moreover, the court below gave claim 2 a meaning quite different from that given it by the Circuit Court of Appeals for the Eighth Circuit which first held the claim valid. It took the position that the word "uniform" in claim 2 means "constant", and on page 646 of its opinion (R. 163, 165) (148 F. [2] 644), referring to the "uniform pressure" of claim 2 of the patent (R. 114), said:

> "The Eighth Circuit also held that the pressure of the spring in Exhibit No. 73 was 'uniform', apparently on the theory that it was a constant pressure. Again, this was right, for the word, 'uni-

> form,' was used as an equivalent of 'constant,' as appears from the specification (p. 1, line 84). Moreover, the springs in the Campbell patent did not themselves exert a 'uniform', if by that is meant an unvarying, pressure."

Again referring to the "uniform pressure", the court below went on to say that it

> "really added nothing because it was inevitable in any 'stabilizer' of the spring type."

This construction is exactly the reverse of that of the Circuit Court of Appeals for the Eighth Circuit, 123 F. (2) 878, which stressed the fact that the "uniform pressure" was a feature that distinguished the claim over the prior art. In the second column on page 880, the Eighth Circuit Court said:

> "It is true that neither Dyer nor Campbell was the first to conceive the idea that shimmy or wobble can be prevented by tightening the joints of the steering mechanism and holding the joints in that position by exerting pressure upon the ends of the steering arms. A similar principle was applied in the prior art [nine patents cited]. These patents have for their primary object the returning to and holding of the front wheels in a straight ahead position. Beale's device by holding the spring under tension *at all times,* is designed also 'to overcome undesirable looseness and wobbling of the front wheels of the vehicle'. The function of these prior art patents of returning the front wheels to a straight ahead position and holding the vehicle in a straight course is achieved by the application of springs to the steering arm so that tension initiated

by any turning movement of the vehicle *will exert an increasing pressure upon the arms.* To the extent that pressure is applied, all of these devices tend to tighten the joints and to overcome wobble or shimmy; but in all of them, except perhaps in Beale, *as pressure is increased upon one arm, it is relaxed upon the other. The novel feature of the Campbell patent,* and to some extent of Dyer, is that the slidable and frictional 'member' which engages the axle *maintains a constant and uniform pressure at all times upon both arms.* This feature both by the means employed and the function performed distinguishes the Campbell patent, and to some extent the Dyer patent, from the means employed and the functions performed by the prior art patents referred to above." (Emphasis added.)

The view of the Court below that "uniform" and "constant" mean the same thing can not be true, for then the phrase "maintains a constant and uniform pressure at all times upon both arms" would be doubly redundant since "constant" and "uniform" would then both mean "at all times". We respectfully call the Court's attention to the criticism of the prior art embodied in the above quotation to the effect that the known devices "will exert *increasing* pressure upon the arms", and that "as pressure is *increased* upon one arm, it is *relaxed* upon the other". We submit that these criticisms are in antithesis of what immediately follows with reference to the Campbell patent, which the Circuit Court of Appeals for the Eighth Circuit described as, contrary to the known devices, having not merely a "constant" but a "uniform" pressure, *i. e.,* the pressure is the *same* at all times in addition to being exerted at all times.

We submit further that if claim 2 is given the broader interpretation that the lower court's opinion gives it, then

the claim loses what the Eighth Circuit Court of Appeals held to be "The novel feature of the Campbell patent". We submit that claim 2 can not both be given an interpretation, as the Court has done, which supports a holding that the Eighth Circuit Court of Appeals did not have to resort to equivalents or to ignore limitations to make claim 2 read on the accused devices, and at the same time be held valid over the prior art as evaluated in the above quotation.

It is plain that in attempting to contradict the view of the district judge below that equivalents and other modifications had to be read into claim 2 to make it read on the accused devices, and that consequently he was justified in reading similar modifications into claims 1 and 3 which resulted in their being infringed by said devices, the Court of Appeals below found it necessary to remove the limitation to "constant pressure" which the Court of Appeals for the Eighth Circuit regarded as the sole novel feature of claim 2, and thereby construed claim 2 so broadly as to render it invalid over the art discussed in the opinion of the Eighth Circuit Court of Appeals.

The court below has also misinterpreted the specification of the Campbell patent. After describing only part of the structure of Figs. 1, 2 and 3, the patent describes such structure, on page 1, line 84, as exerting "a constant pressure against the outer end of the connecting rod 4". However, after describing additional structure the patent says on page 1, lines 95 to 99:

> "By means of this construction, the spring forms means for affording a substantially uniform resistance against movement of the connecting rod 4 and spindle arms 3 in either direction."

It is evident that lines 84 and 96 refer to different structural aggregations and to different actions of the

spring. If the word "uniform" meant only constant, there was no reason for qualifying it by "substantially" in line 96, for there is no qualification in line 84. Obviously it is easy to obtain a constant or continuous pressure, but it is not so easy to obtain a uniform or unvarying pressure, and hence the hedging word "substantially".

The foregoing shows that the opinions of the two Circuit Courts of Appeal are contradictory, and this calls for review by this Court.

It may be that the court below was embarrassed by the fact that claim 2 defines only a single spring and that such single spring cannot produce unvarying pressure, something which the Court of Appeals for the Eighth Circuit overlooked when it held the claim valid, but that is no reason for ignoring the limitation in the claim. Where a patentee has inserted limiting words in a claim, he is bound by such limitations. When an applicant for a patent restricts a claim, he disclaims or abandons that which is outside the scope of his limitations. In *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, this Court said, referring to the interpretation of a phrase substituted for a former phrase in a claim:

> "The difference which he thus disclaimed must be regarded as material, and since the amendment operates as a disclaimer of that difference it must be strictly construed against him. *Smith* v. *Magic City Kennel Club, supra,* 790 [282 U. S. 784]; *Shepard* v. *Carrigan,* 116 U. S. 593, 598; *Goodyear Dental Vulcanite Co.* v. *Davis,* 102 U. S. 222, 228."

As in *Altoona Publix Theater, Inc.* v. *American Tri-Ergon Corporation,* 294 U. S. 477, 487:

> "The patent thus upheld is one which was neither claimed nor granted."

The foregoing is believed to show also that the court below was also in error in applying the principle of *res judicata* and denying petitioner a trial on the merits because the legal issues here, including the interpretation of claim 2 and the question of the infringement of claims 1 and 3 by the accused devices are different from the legal issues in the Missouri Actions.

CONCLUSION.

It is respectfully urged that the writ of certiorari prayed for be granted.

Respectfully submitted,

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